

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD RUBIN

Appeal 2006-2279
Application 09/664,885
Technology Center 3700

Decided: May 25, 2007

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
CHARLES F. WARREN, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals the final rejection of claims 1-20¹ under 35 U.S.C. § 134. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

¹ Claims 18 and 19 contain informalities deserving of correction. Specifically, claim 18 refers to “the passive opening” and claim 19 refers to “the closure” which lack antecedent basis. In any further prosecution of this application, these informalities should be corrected.

We AFFIRM.

INTRODUCTION

Appellant invented a food storage device for keeping food warm and moist (Specification 1). Appellant's device includes a pouch that bounds an insulated and substantially water impermeable food-warming chamber (Specification 3). The pouch has opposing substantially coextensive lips that are capable of being moved apart for insertion of food into the food-warming chamber and to provide a partial vapor lock for the warming chamber (Specification 3). The partial vapor lock formed by the lips permits water vapor to pass between the lips, which prevents moisture from building up in the warming chamber and the food stored therein from becoming soggy (Specification 3).

Claim 14, the broadest claim on appeal, is illustrative:

14. Apparatus for storing and keeping food warm and moist comprising:

a soft and flexible insulated pouch having a substantially water impermeable warming chamber and lips;

a non-sealing engagement between the lips causing a partial enclosure of the warming chamber;

the partial enclosure caused by the non-sealing engagement between the lips inhibiting moisture vapor produced from warm food disposed in the warming chamber from building up in the warming chamber, which prevents warm food disposed in the warming chamber from becoming soggy and allows enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist.

The Examiner relies on the following prior art reference as evidence of unpatentability:

| | | |
|-------|--------------|---------------|
| Walsh | US 3,428,103 | Feb. 18, 1969 |
|-------|--------------|---------------|

The rejection as presented by the Examiner is as follows:

1. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walsh.

Appellant indicates that “all of the claims stand or fall together” (Br. 7). Accordingly, we select claim 14, the broadest claim on appeal, as the representative claim, which we discuss in our opinion below.

OPINION

RES JUDICATA ISSUE

The claims on appeal were subject to a previous decision by the Board of Patent Appeals and Interferences. *Ex parte Rubin*, 2004-0940 (BPAI 2004). In that decision, the Board reversed all of the Examiner’s rejections over prior art different from that used in the § 103(a) rejection currently on appeal. After receiving the Board’s decision, the Examiner, with Technology Center Director approval, made a new § 103(a) rejection over Walsh. The Walsh patent was previously cited by the Examiner on March 6, 2002 in a Notice of References Cited (PTO-892) form, but was never used in any rejection.

Appellant argues that “res judicata makes reopening prosecution improper, when the rejection is on the same cited prior art considered prior to winning the appeal” (Br. 9). Appellant, relying on *Jeffry Mfg. Co. v. Kingsland*, 179 F.2d 35, 83 USPQ 494 (CA DC 1949), contends that

“reopening prosecution after losing an appeal without citing new art is improper” (Br. 8).

Appellant’s arguments are unpersuasive for several reasons.

First, the Court of Appeals for the Federal Circuit addressed the same factual situation presented in this appeal in its non-precedential decision, *In re Conte*, 36 Fed. Appx. 446 (Fed. Cir. 2002) and held that the Examiner may consider references of record in reopening prosecution after a Board reversal.

In *Conte*, after the Board reversed the Examiner’s § 103 rejection, the Examiner reopened prosecution making §§ 102 and 103 rejections over art that was previously cited by the Examiner. *Id.* at 448-49. The Appellant in *Conte* argued that the “PTO erred in rejecting the claims over references previously of record.” *Id.* at 449. However, the court ruled that “. . . the examiner, upon reopening prosecution, could consider the references of record.” *Id.* at 450. The *Conte* court went on to state that “[t]he field of references available to the examiner is not so constrained [such that references of record are removed from further scrutiny by the examiner] . . . for examination of claims following a Board reversal of an earlier rejection.” *Id.* Citing to 37 C.F.R. § 104(c)(2), the court further reasoned that the field of prior art post-Board reversal should not be limited to only prior art not of record because “in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.” *Id.*

Second, the courts have enunciated a strong public policy against rigidly applying the doctrine of res judicata to patent prosecution. Regarding the use of the doctrine of res judicata in patent prosecution, the Court of Customs and Patent Appeals held:

. . . the policy and purpose of the patent laws preclude the applicability of any doctrine akin to the judicially-developed doctrine of ‘res judicata’ to bar the granting of patents on inventions that comply with the statute. The same policy and purpose precludes reliance on any such doctrine to force the granting of patents on inventions that do not comply with the statute. The Patent Office must have the flexibility to reconsider and correct prior decisions that it may find to have been in error. [*In re Borkowski*, 505 F.2d 713, 718, 184 USPQ 29, 32-33 (CCPA 1974).]

Third, the *Jeffry* decision cited by Appellant is distinguishable from the facts of this appeal. *Jeffry* involved a reversal by the Court of Custom and Patent Appeals of the Board’s decision affirming the examiner. *Jeffry*, 179 F.2d at 35-36, 83 USPQ at 495. Moreover, in *Jeffry*, after the reversal by the CCPA the examiner applied a “newly discovered reference” (i.e., a reference not “previously cited”). *Id.* at 494. In contrast, the present appeal involves a reversal by the Board, and the Examiner has applied art that is of record, not a “newly discovered reference.”

For the above reasons, we determine that the doctrine of res judicata does not apply to the current appeal. Rather, following the Federal Circuit’s reasoning in *Conte*, the Examiner may use a reference that is of record to reopen prosecution following reversal by the Board.

35 U.S.C. 103(a) REJECTION OVER WALSH

Appellant argues that Walsh fails to disclose “a pouch including a layer formed of a film of plastic material to provide water impermeability” (Br. 13). Appellant further argues that Walsh does not disclose the claim feature “the lips formed to provide a passive, non-sealing engagement

between the lips” (Br. 13).² Appellant contends that Walsh does not describe or show “lips” (Br. 13). Rather, Appellant contends that Walsh discloses an opening having a zipper for sealing the opening (Br. 14). Appellant further states that Walsh’s zipper does not constitute “lips” as claimed (Br. 15). Citing to *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), Appellant argues that modifying Walsh’s container by removing the zipper or leaving it open would render the container unsatisfactory for its intended use (Reply Br. 3). Appellant further contends that because Walsh’s container uses a zipper to seal the container, it is not capable of performing the intended function of “passive, non-sealing engagement between the lips” as claimed (Reply Br. 4).

We are unpersuaded by Appellant’s arguments for the reasons discussed below.

First, as the Examiner indicated, Appellant’s first argued distinction regarding the “water impermeability” claim feature is met by Walsh’s disclosure that “outer layer 30 and inner layer 36 should be . . . waterproof . . .” (Walsh, col. 2, ll. 30-31; Answer 6). Appellant does not contest in his Reply Brief the Examiner’s position regarding Walsh’s “waterproof” disclosure.

Second, Appellant has not defined the claim term “lips” in his Specification such that the Examiner’s construction of “lips” would be governed by Appellant’s definition. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005). Appellant only discloses,

² Claim 14 recites, in relevant part, “a non-sealing engagement between the lips causing a partial enclosure of the warming chamber.” Claim 14 does not recite the “passive” claim feature present in claims 1 and 8.

“Lips 30 and 31 are constructed and arranged so that they normally loosely associate or mingle with one another or otherwise rest against one another passively” (Specification 10).

Walsh discloses an insulated container 10 having an opening provided in front 24 to permit insertion of article 40 into the insulated container 10 (Walsh, col. 2, ll. 41-44). The insulated container is made of a laminate of plastic layers and resilient foam material (Walsh, col. 2, ll. 30-40). As shown in Figure 5, the opening has a zipper 42 with one half of the zipper on the upper portion of the opening and the second half of the zipper on the lower portion of the opening (Walsh, Figure 5).

The Examiner construes Appellant’s claimed “lips” as corresponding to Walsh’s front 24 having the opening (Answer 6). Based on this construction of “lips”, the Examiner finds that after the article 40 is inserted into the container 10 through the opening (as shown in Figure 3) the “resilient” foam insulation permits the upper and lower half of zipper 42 to be in “non-sealing engagement” upon one another prior to zipping (Answer 4, 7). Moreover, the Examiner states that Walsh’s “lips” are capable of preventing moisture build up in the container (Answer 4-5).

We discern no structural difference between Appellant’s and Walsh’s “lips.” Walsh’s “lips,” like Appellant’s “lips,” are constructed and arranged to rest upon one another (i.e., the bottom of the upper half of the zipper on the upper “lip” touches the top of the lower half of the zipper on the lower “lip”). Accordingly, we agree with the Examiner that Walsh’s “lips” are inherently capable of performing a non-sealing function such that moisture build-up and the other functions recited in Appellant’s claim 14 are satisfied

by Walsh. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

We are equally unconvinced by Appellant's argument that modifying Walsh so that zipper 42 is left open would render Walsh's container unsatisfactory for its intended use. The Examiner is not structurally modifying Walsh. Rather, we understand the Examiner to be stating that prior to closing the zipper 42 on the container 10, Appellant's claims are structurally satisfied by Walsh. We agree.

Generally, a prior art product that possesses a claim feature at any time would satisfy the claim feature. *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1558, 35 USPQ2d 1801, 1805-06 (Fed. Cir. 1995). Therefore, as shown in Walsh's Figure 5, once the article 40 is inserted and the upper and lower half of the opening in front 24 come to rest upon one another, Appellant's "non-sealing lip" claim feature is satisfied by Walsh.

Though the Examiner rejected claim 14 under § 103(a), we fail to see any of the features of claim 14 as not being disclosed by Walsh. For example, the Examiner's statement of the § 103(a) rejection indicates that Walsh's disclosure "is unclear if the layers of plastic material are film and/or cloth." However, claim 14 does not recite a plastic film or cloth. Accordingly, since all of the features of Appellant's claim 14 are either explicitly or inherently disclosed, claim 14 lacks novelty and is anticipated by Walsh. Anticipation is the epitome of obviousness. *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 572 (CCPA 1982).

For the above reasons, we affirm the Examiner's § 103(a) rejection of claims 1-20.

DECISION

The Examiner's rejection of claims 1-20 under § 103(a) over Walsh is
AFFIRMED.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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Parsons & Goltry
4000 N. Central Ave.
Suite 1220
Phoenix, AZ 85012